

REMARKS

CLAIM AMENDMENTS

Claims 1, 16 and 42 have been amended to explicitly recite what was implicitly recited by these claims. This amendment was not made for the purpose of patentability, but instead to add clarity to the claims. This amendment has added no new matter to the application.

35 USC §102(b) REJECTIONS

The Office Action has rejected claim 1 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,860,012 (Luu). Applicants respectfully traverse this rejection.

The Office Action has rejected claims 16, 17, 19, 20, and 22 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,809,251 (May). Applicants respectfully traverse these rejections.

Claim 1

Claim 1 recites a method for installing software onto a remote client machine that comprises the elements of:

- (1) initiating a connection at a server to the client machine, (2) transmitting an installation service that installs software, the installation service transmitted from the server to the client machine based on the connection initiated by the server, and
- (3) executing the installation service on the client machine.

In order to support an anticipation rejection under §102, a single prior art reference must disclose each and every element recited in a claim, and that each element is arranged as in the claim. Applicants respectfully submit that Luu does not meet these requirements with respect to the elements recited in claim 1.

The Office Action contends that Luu teaches the recited elements (1) – (3) at Col. 2, lines 2-6. The cited section of Luu states:

the installation package transmitted to the user's workstation where a *program* carries out commands in the installation package for installing the application software (emphasis added).

As discussed in the interview with the Examiner on October 8, 2003, Applicants respectfully submit that the cited section of Luu does not teach or suggest the elements recited by Applicants in claim 1, including the concept of a transmitted installation service that installs software.

Instead, a program already present on Luu's machine installs the software, not the Luu installation package. More particularly, the Luu installation package 303 of FIG. 3 and 503 of FIG. 5 is a text file that comprises data to be operated upon (or carried out) by Luu's *special installation program* (302 of FIG. 3 and 601 of FIG. 6) *that is already stored* on the user workstation 202. The installation package is merely text data interpreted by this already-present "special installer program" of Luu, and is thus not an installation service as recited by Applicants.

For example, the Luu installation package is a text data file that is specific to each application program to be installed, and contains the differences between

a baseline application software 501 of FIG. 5 and a to-be-installed updated application software 502 of FIG. 5. In fact, Luu teaches that the installation package is an IPACK format file (col. 5 lines 7-12), and that the already-present installation program 601 (or Installer) receives the installation package 602 and a personality file 603, to install the updated application software 604 (col. 7 lines 14-18) in the workstation 202. Luu describes the IPACK file format in Appendix A (col. 5 lines 7-12). The IPACK format file is a text file (Appendix A cols. 11 & 12) containing descriptions of added files, deleted files, replaced files (Appendix col. 15 & 16), and modified files (Appendix col. 27 & 28). Illustratively, the IPACK file format ModifiedTextFile (Appendix A cols. 27 & 28) has data describing changes to be made to specific text files of an application program during the installation process, as described by simple script (Appendix A cols. 27 & 28). The Luu ModifiedTextFile describes data syntax rules, such as: text in *italics* denoting a replaceable parameter, and **Bold** text denoting keywords (Appendix A cols. 29 & 30).

It appears that the Office Action has mistakenly thought that the transmitted text data (installation package) is the entity that installs the software, and failed to recognize that Luu's special installer program is the program that does so. However, text is simply text; it does not execute to install anything, but can only be interpreted. In actuality, the updated application is installed in Luu by the already present, special installer that modifies a baseline application software in a user workstation 202 (col. 6 lines 7-33) by interpreting the installation

package, in a method described with reference to FIG. 4. In other words, the cited section of Luu describes the installation-related text data (the installation package) being transmitted to the target machine, where a special *user-stored* installation program operates on that data to install application software, based on an earlier version of the application software.

The difference is significant, because unlike Luu, Applicants' installation service installs software without the need of a preexisting installation program already residing on the target machine, (or for that matter a version of a to-be-installed application program already residing on the target machine). Luu's installation program is taught as needing to be already present, and thus Luu does not disclose transmitting such an installation service that installs software, as claimed; if anything, Luu teaches away from this aspect of applicants' invention.

Moreover, the installation service of Applicants' claimed invention is transmitted from a server machine to the client machine based on a connection initiated by the server to that client. By transmitting an installation service that installs software, Applicants' claimed technique provides significant advantages over Luu, as Luu's model is like those essentially set forth in the background section of the present application. For example, as described in Applicants' background section, in Luu, without more, someone (such as each user or a team of administrators) has to physically go around to each machine and manually put the "special installation program" on that machine so that it can

be present to do the application update, when later needed. As further described in Applicants' background section, although not contemplated by Luu, it may have been alternatively possible for Luu to put its "special installation program" on a machine via some client logon script mechanism, however this would rely on the *client* initiating the connection, and thus has other significant disadvantages, as also explained in Applicants' background section. The present invention overcomes these drawbacks by "initiating a connection at a server to the client machine, and transmitting an installation service that installs software, the installation service transmitted from the server to the client machine based on that connection." Luu, which starts with the assumption that its "special installation program" is simply already present on a machine, from being put there in a conventional way, clearly does not do this.

Luu does not disclose each and every element recited in claim 1, and for that reason Applicants respectfully submit that Luu does not anticipate Applicants' claim 1 as a matter of law. Applicants respectfully request that the rejection of claim 1 be withdrawn, and claim 1 be allowed.

Claim 16

Claim 16 in general recites a system for selectively installing management software onto remote client machines, which comprises the elements of:

(1) a data manager for evaluating information associated with a plurality of discovered remote client machines, and for selecting one of the remote client machines as a selected client machine; (2) a configuration manager for initiating a connection to the selected client machine; and (3) an installation service

transmitted by the configuration manager to the selected client machine, the installation service installing at least part of the management software on the selected client machine.

The Office Action contends that May teaches element (3) at col. 13, lines 59-64, by allegedly teaching an installation service transmitted to the client machine which installs software on the client machine.

Applicants respectfully traverse this contention. As discussed in the interview of October 8, 2003, Applicants respectfully submit that like Luu, May also does not disclose an installation service as recited by Applicants, let alone one transmitted to a selected client machine among a plurality of discovered machines.

In contrast to claim 16, May describes downloading *application* software from an MIS to a remote computer, if a version of the software is already installed on the remote computer (col. 7 lines 4-15) (emphasis added). Nowhere in May is there a teaching or suggestion of an installation service that installs at least part of management software on a selected client machine, as recited in claim 16. In fact, the cited portion of May (col. 13 lines 59-64) describes an MIS on a server deciding to download updated application software to a remote computer. The cited section of May does not disclose generally transmitting an installation service to a client, let alone an installation service that installs management software on the selected client machine.

Claims 17, 19, 20 and 22

Claims 17, 19, 20 and 22 are directly or indirectly dependent on claim 16, and for at least that reason, May does not disclose each and every element recited in these claims. Moreover, claims 17, 19, 20 and 22 are further patentable for additional elements they contain.

As one example, claim 17 recites the data manager selecting the client machine by evaluating discovery information associated with the client against criteria. Applicants find no description in May regarding anything even remotely resembling a data manager evaluating discovery information (e.g., information pertaining to the location or other identification of client machines on the network), or selecting the client machine by evaluating the discovery information. The Office Action contends that May col. 13 lines 49-55 teaches these elements, however Applicants submit this portion of May instead describes the May MIS obtaining *current application version information* from the remote computer, and performing acts to update that remote computer when that remote computer's software requires updating. This is an entirely difference concept, and Applicants respectfully submit that May does not anticipate Applicants' claims 17, 19, 20 and 22. Applicants respectfully request that the rejections of claims 17, 19, 20 and 22 be withdrawn for at least these additional reasons, and that claims 17, 19, 20 and 22 be allowed.

35 USC §103(a) REJECTIONS

The Office Action has rejected claims 2-15, 18, 21, 23-34, 38-39, and 40-41 under §103(a) as being unpatentable over Luu in view of May. Applicants respectfully traverse these rejections.

The Office Action has rejected claims 42 and 51 under §103(a) as being unpatentable over Luu in view of U.S. Patent No, 5,995,756 (Herrmann). Applicants respectfully traverse these rejections.

The Office Action has rejected claims 35 and 37 under §103(a) as being unpatentable over Luu in view of May and in view of U.S. Patent No, 5,809,251 (Lerche). Applicants respectfully traverse these rejections.

The Office Action has rejected claims 35 and 37 under §103(a) as being unpatentable over Luu in view of May and in view of U.S. Patent No, 5,809,251 (Lerche). Applicants respectfully traverse these rejections.

The Office Action has rejected claims 43-47, 49, and 50 under §103(a) as being unpatentable over Luu in view of May and in view of Herrmann. Applicants respectfully traverse these rejections.

The Office Action has rejected claim 48 under §103(a) as being unpatentable over Luu in view of May and in view of Herrmann and Lerche. Applicants respectfully traverse this rejection.

Claims 2-15, 18, 21, and 23-26

Applicants respectfully submit that claims 2-15, 18, 21, and 23-26 are patentable over Luu in view of May for two reasons, any one being sufficient to render the claims patentable. First, Luu and May, together or alone, do not disclose all the elements recited by Applicants. And second, there is no suggestion, motivation, or teaching in May or Luu to combine the teachings of Luu with May.

First, Luu and May, together or alone, do not disclose all the elements recited by Applicants. Dependent claims 2-15 are allowable by virtue of their dependency on base claim 1, because as discussed above with reference to the §102 rejection of claim 1, all the elements of claim 1 are not disclosed in Luu, and in making the §103(a) rejection of these claims, the Office Action does not contend that any of these missing elements are somehow disclosed elsewhere in the prior art. Dependent claims 18, 21, and 23-26 are likewise allowable by virtue of their dependency on base claim 16, because as discussed above with reference to the §102 rejection of claim 16, all the elements of claim 16 are not disclosed in May, and the Office Action does not contend that any of these missing elements are somehow disclosed elsewhere in the cited prior art. Furthermore, claims 2-15, 18, 21, and 23-26 are allowable by virtue of additional elements they contain.

As one example, claim 2 recites that initiating a connection includes discovering the client machine, e.g., determining the location or other

identification of client machines on the network. Applicants find no description in May of discovering a client machine. The Office Action concedes that May does not explicitly teach discovering the client machine. Instead, the allegation appears to be that May's MIS may have location information for each remote computer. However in contrast to the claims, such location information is not taught as being inherently or expressly obtained by any discovery mechanism whatsoever in the prior art; discovery comes from applicants' teachings.

Notwithstanding this fundamental distinction, the Office Action contends with respect to the claims that recite discovering client machines (e.g., claims 2-8, and 18) that, in May, the client is "discovered" by obtaining the client software image. However, the software image in May is requested and then received by the MIS from a *specific and already-connected* client to inform the MIS of that client's software version numbers for determining whether the client software is upgraded (FIGS. 7A & 7B, col. 1 line 64 - col. 8 line 5). Since such a client is already connected, it is nonsensical to say such a client is discovered, let alone to allege that asking an already-connected client for data is somehow further related to determining the clients on the network.

As other examples, claim 13 recites (1) the installation service is a bootstrap service, (2) running the bootstrap service connects the client machine to another server, and (3) transmitting additional software from the other server. Neither Luu nor May disclose these elements. Claim 23 recites that the installation service comprises a bootstrap service for installing management

software on the selected client machine, and neither Luu nor May disclose these elements. Claims 24 - 26 depend from claim 23 and are allowable by virtue of this dependency as well as for the additional elements they contain. For instance claim 24 recites that the additional management software recited in claim 23 is downloaded from a client access point; claim 25 recites that the bootstrap service is configured to connect the client machine to another server; and claim 26 recites that the other server transmits additional software for installing on the client machine wherein the additional software installs optional components on the client machine. Neither Luu nor May disclose any of these elements.

Moreover, there is no teaching, suggestion, or motivation to combine Luu with May. Indeed, the method and system described in Luu and May are incompatible with one another, each addressing differing ways to update already existing software on a computer. Luu addresses a method and system to update applications on computers by analyzing the differences between a pre-updated software version and an updated software version, and transmitting those differences to the computer client for generating an updated version. An already-stored installer executes files describing difference between a baseline application and an updated application to generate an updated application from the baseline application. On the other hand, May addresses a method and system to install updated software on a computer by determining the versions of the software on the computer, and if the versions indicate a need to update the software, transmitting new software to the computer, where an already-stored

installer (again) loads the new software. May also addresses software metering by a remote computer of software usage on the computer. Applicants cannot find an indication anywhere in Luu or May of any motivation, suggestion, or teaching to combine Luu with May, that would somehow be directed towards the present invention.

For any of these additional reasons, Applicants respectfully submit that claims 2-15, 18, 21, and 23-26 are each patentable over Luu in May in any permissible combination. Applicants respectfully request that the §103(a) rejections of claims 2-15, 18, 21, and 23-26 each be withdrawn and that these claims be allowed.

Claim 27

Claim 27 recites a method that includes transmitting an installation service from a server to a client machine, and executing the installation service. The Office Action contends that Luu teaches both transmitting an installation service from a server to a client, and executing the installation service. As discussed above with respect to claim 1, Luu neither describes transmitting an installation service from a server to a client, nor executing the installation service. Therefore Luu and May together or alone do not describe all the elements recited by Applicants. Moreover, as described above with reference to claims 2-15, 18, 21, and 23-26, there is no teaching, suggestion, or motivation to combine Luu with May.

For any of these reasons, Applicants respectfully submit that claim 27 is patentable under §103(a). Applicants respectfully request that the §103(a) rejections of claim 27 be withdrawn and claim 27 be allowed.

Claims 28-34 and 38-41

Applicants respectfully submit that claims 28-34, and 38-41 are not obvious over Luu in view of May because any such combination of Luu and May is impermissible by law. First, Luu and May, together or alone, do not disclose all the elements recited by Applicants. Note that dependent claims 28-34, and 38-41 are also allowable by virtue of their dependency on base claim 27, because as discussed above, the elements of claim 27 are not disclosed in Luu and May. Moreover there is no suggestion, motivation, or teaching in Luu or May to combine the teachings of Luu with May. Furthermore, these claims are allowable by virtue of the additional elements they contain. For instance, claim 28 recites evaluating discovery information associated with the client machine, which, as discussed above, is simply not disclosed in the prior art of record. Claim 38 recites the installation service and a bootstrap service and transmitting additional software from another server, and as also discussed above, Luu or May do not disclose these elements. For any of these reasons, Applicants respectfully submit that claims 28-34, and 38-41 are each patentable under §103(a). Applicants respectfully request that the §103(a) rejections of claims 28-34, and 38-41 each be withdrawn and claims 28-34, and 38-41 each be allowed.

Claims 35-37

Applicants respectfully submit that claims 35-37 are patentable over Luu in view of May and in view of Lerche, because Luu, May, and Lerche together or alone, do not disclose all the elements recited by Applicants, and because there is no suggestion, motivation, or teaching in May, Luu, or Lerche to combine the teachings of Luu, May and Lerche.

First, Luu, May, and Lerche together or alone, do not disclose all the elements recited by Applicants. Note that dependent claims 35-37 are allowable by virtue of their dependency on base claim 34, because as discussed above, all of the elements of claim 34 are not disclosed in Luu and May, and the Office Action does not contend that the missing elements are somehow found in Lerche. Furthermore, claims 35-37 are allowable by virtue of the additional elements they contain, (including claim 36 which the Office action has indicated as being allowable).

For instance, claim 35 essentially recites determining if the installation service executed successfully, and if not, reattempting execution of the installation service. The Office Action admits that Lerche does not teach reattempting execution if the first attempt is unsuccessful, but contends that it would be obvious to reattempt execution of installation. Applicants traverse. In Lerche the software that is executed is an application, and not an installation service as recited by Applicants. Lerche does not disclose how an installation

service could be loaded and then executed or re-executed. In Lerche, any installation program is presumed to already be stored on the Lerche remote modem, and already successfully used, so that the Lerche application can be executed. Claim 37 recites queueing the configuration request having the data removed therefrom. Simply put, Luu, May, or Lerche do not include these elements. Moreover there is no suggestion, motivation, or teaching in Luu, May, or Lerche to combine the teachings of Luu with May and Lerche.

For any of these reasons, Applicants respectfully submit that claims 35-37 are each patentable under §103(a). Applicants respectfully request that the §103(a) rejections of claims 35-37 each be withdrawn and claims 35-37 each be allowed.

Claim 42

Applicants respectfully submit that Luu and Herrmann together or alone do not disclose all the elements recited by Applicants with respect to claim 42. First, as discussed with respect to claim 1 above, Luu fails to disclose initiating a connection at a server to the client machine, or transmitting an installation service from a server to a client based on that connection. Herrmann, even if somehow permissible to combine with Luu, also does not disclose such limitations, and thus unquestionably fails to cure this glaring deficiency of Luu. Applicants respectfully submit that neither Luu nor Herrmann provide any description of a conditional approach as generally recited in claim 42, e.g., where

if a user has sufficient security rights, the client machine executes a process at the client machine to install the software, and if a user does not have sufficient security rights, a server initiates transmitting an installation service from a server to the client machine and executing the installation service to install the software.

Moreover, Applicants respectfully submit that there is no suggestion, motivation, or teaching in Luu, or Herrmann to combine the teachings of Luu with Herrmann. As explained in Applicants' prior response, combining Luu with Herrmann is an example of clearly impermissible hindsight reasoning.

For any least the reasons above, claim 42 is patentable over Luu in view of Herrmann. Reconsideration and withdrawal of the rejections of claim 42 based on Luu and Herrmann, and the claims that depend from claim 42 (including claim 51), is respectfully requested.

Claims 43-51

Applicants respectfully submit that claims 43-47, and 49-51 are patentable over Luu in view of May and Herrmann for two reasons, any one being sufficient to render the claims not obvious. First, Luu, May, and Herrmann together or alone, do not disclose all the elements recited by Applicants, as discussed above. And second, there is no suggestion, motivation, or teaching in May, Luu, or Herrmann to combine the teachings of Luu with May and Herrmann.

As discussed above, Luu, May, and Herrmann, whether considered alone or in any permissible combination, simply do not disclose all the elements recited

by Applicants. Dependent claims 43-47, and 49-51 are allowable by virtue of their dependency on base claim 42, because as discussed above with reference to the §103(a) rejection of claim 42, all the elements of claim 42 are not disclosed in Luu and Herrmann, and the Office Action does not contend that any of these elements are somehow disclosed in the other prior art of record, including May. Furthermore, these claims are allowable by virtue of the additional elements they contain. As but one example, claim 43 recites evaluating discovery information, which, as discussed above with reference to claims 2 and 3, is not disclosed anywhere in May. Claim 49 recites that the installation service comprises a bootstrap service, which as discussed above with reference to claim 13, is not disclosed by May or Luu.

Claim 48 is also not obvious over Luu in view of Herrmann and Lerche for at least the reasons set forth above, and further because in Lerche, the software that is executed is an already-installed application, not an installation service. Lerche does not disclose how an installation service could be loaded and then executed or re-executed as recited in claim 48.

CONCLUSION

In view of the foregoing remarks, it is respectfully submitted that claims 1-51 are patentable over the prior art of record, and that the Application is otherwise in good and proper condition for allowance. Withdrawal of the rejections is respectfully requested.

If in the opinion of the Examiner a telephone conference would expedite the prosecution of the subject Application, the Examiner is invited to call the undersigned attorney at 425-836-3030.

Respectfully submitted,



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